

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/287,023 04/06/99 MALIK

D BS100/176677

023370
JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

WM01/0410

EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/287,023

Applicant(s)

MALIK

Examiner

Duc M Nguyen

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____

Art Unit: 2643

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill (5,991,749).

Consider claims 1-3, 8-10, 12-13, 18-21, 26-29, 34. Morrill teaches a method for using a communication to conduct a transaction (e.g., transferring fund between phone or financial account; column 1 lines 30-40; column 2 lines 18-32) with respect to a telecommunications account (the mobile phone number of the recipient; column 2 line 60 to column 3 line 36), comprising the calling line is met by the caller's cell phone number; the transaction amount is met by (column 2 lines 33-59); the billing system is met by the CPU (column 2 line 60 to column 3 line 36). All other limitations of claim 1 are met by Morrill teachings (column 4 lines 17-38; column 3 line 65 to column 6 line 13).

Morrill does not teach the use of this method in an advance intelligent network (e.g., SS7). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Morrill above teachings into the AIN (advance intelligent network)

Art Unit: 2643

without changing the scope of the claimed subject matter which is to provide a variety of payment methods to caller so that caller can choose a suitable and convenient method to transfer fund between different accounts.

Consider claims 4-6, 11, 15-17. Morrill further teaches the use of a PIN or an unique user account code (column 2 line 60 to column 3 line 5) which reads on the validation step in claims 4-6, 11, 15-17.

Consider claims 7, 14. Morrill further teaches the CPU confirms completion of the transaction by generating and displaying a transaction confirmation/authorization number code (column 3 lines 6-19) which reads on the limitations of claim 7, except for the step of providing an announcement to the communication. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to announce a transaction confirmation/authorization without changing the scope of the claimed subject matter which is to provide the user with confirmation message so that the user knows for sure that the transaction went smoothly and completely.

Consider claims 22-25, 30-33. Morrill further teaches that the transfer is reflected as a debit on the user's phone bill and as a credit on the recipient's mobile phone statement, along with any phone usage or transaction charges (column 3 lines 24-27); transactions are reflected directly on the user's and recipient's bank, credit card, or other periodic bill/statement, with only phone usage or transaction charges, if any, shown on the mobile phone statement (column 3 lines 20-36).

Art Unit: 2643

Response to Arguments

3. Applicant's arguments filed 1/22/2001 have been fully considered but they are not persuasive.

Applicant states "the rejections of the other claims, claims 2-3, 8-10, 12-13, 18-21, 26-29, 34, are unsupported at least because these claims are not addressed in the office action." In response to that statement, the examiner clearly addresses these claims under a 103 rejection (e.g., Consider claims 1-3, 8-10, 12-13, 18-21, 26-29, 34). It is clearly that the paragraph that follows the header "Consider claims 1-3, 8-10, 12-13, 18-21, 26-29, 34" directs to the rejection of claims 1-3, 8-10, 12-13, 18-21, 26-29, 34.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the billing system in a telecommunications system such as covered by some of the pending claims does not interact with callers or telephones) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Morrill does not teach nor suggest subject matter such that a telecommunications system other than a wireless system could be used for conduct of financial transaction and other activities, a recitation of the intended use (i.e., a method for using; see claims 1-17, 34) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

Art Unit: 2643

the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is noted that “for use” is not a positive limitation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Morrill above teachings into the AIN (advance intelligent network) without changing the scope of the claimed subject matter which is to provide a variety of payment methods to caller so that caller can choose a suitable and convenient method to transfer fund between different accounts.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2643

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

Any response to this final action should be mailed to:

Box AF


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-6306 or (703) 308-6296

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

April 4, 2001


DUC NGUYEN
PRIMARY EXAMINER